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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,249	07/25/2000	Paul J Berlowitz	JNP-0007	7631

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EXAMINER
MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/625,249	BERLOWITZ ET AL
	Examiner	Art Unit
	Margaret B. Medley	1714

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This action is in response to Paper No. 16 and Paper No. 17, dated March 4, 2003. The pending claims of record are claims 1-7. The terminal disclaimers for Patent No. 6,162,956 and Patent No. 6,180,842 have been made of record. An action on the merits appears below.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 10-11 of U.S. Patent No. 6,274,029 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the F-T fractions and the petroleum of the instant claims encompass and render obvious the F-T fraction and the petroleum derived hydrocarbon of patentees.

Claims 1-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-7 and 10 of U.S. Patent No. 6,309,432 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the F-T fraction and virgin distillate blend of the instant claims encompass and render obvious the F-T fraction and jet fuel (petroleum or hydrocarbon containing feeds of about the same boiling range) blend of patentees.

Claims 1-7 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 18-19 of copending Application No. 08/971,254. Although the conflicting claims are not identical, they are not patentably distinct from each other because the F-T fraction and virgin distillate blend of the instant claims encompass and render obvious the F-T fraction and petroleum derived hydrocarbon (including virgin distillates) blend of applicant).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-27 of copending Application No. 09/882,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because the F-T fraction and virgin distillate blend of the instant claims encompass and render obvious the F-T fraction and petroleum derived hydrocarbon (liquid product of crude oil) of applicants.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (Berlowitz) 5,689,031 for reasons made of record in Paper No. 13 dated October 01. 2002.

Applicant's arguments filed March 4, 2003 have been fully considered but they are not persuasive.

In view of applicants' amendment to claim 1 and arguments made of record at pages 2-3 of Paper No. 16 dated March 4, 2003 the 35 U.S.C. 112 first paragraph rejections are withdrawn.

In view of applicants filing of the proper fees and terminal disclaimers, the obviousness-double rejections over U.S. Patent No 6,180,842 and 6,163,432 are withdrawn.

In view of applicants made of record at page 5 of Paper No. dated March 4, 2003 the 103 obviousness rejection over claims 5-7 are withdrawn.

Applicants argue that Berlowitz only requiring 10% F-T distillate clearly indicates that the applicants never contemplated blending F-T distillates with virgin distillates to achieve a very specific product with specific characteristics.

The examiner after having studied and reviewed the pending claims 1-7, concurs with applicants' arguments with respect to pending claims 5-7. However, pending claims 1-4 are devoid of relative proportions for F-T distillates and with virgin distillate. Further claims 1-4 are not commensurate in scope with the argument presented of record and the relied upon data of record showing ratio of 99/1 to 50/50 FT/raw distillate. Therefore, the teachings of patentee render obvious the instant pending claims 1-4.

Applicants have invited the examiner to revisit the 37 C.F.R. Section 132 affidavit filed by inventor Berlowitz on June 17, 2002, which states that an experiment mixing of a F-T stream with a light catalytically cracked oil (which is taught in claim 11 of the '029 patent) is the basis to overcome the obviousness double paten rejection.

The examiner has carefully studied the Berlowitz Rule 132 declaration as well as patent '029. A review of claim 11 and lines 29-37 of the patent '029 discloses petroleum or hydrocarbon containing feeds of about the same boiling range of the F-T and include

refinery diesel streams e.g., raw or hydrogenated catalytic or thermally cracked distillates and gas oils that render obvious the instant claims. Thus the obviousness double patent rejection is proper rendering the instant claims obvious.

Applicants argue that there is no teaching in Patent '432 to blend the distillates to obtain a resulting blend with improved stability. The examiner disagrees with applicants' arguments in that the claims are not directed to a method nor a process. The petroleum and hydrocarbon containing feeds having about the same boiling point range of F-T distillate, column 4 lines 49-51, of patentee is similar or the same blend of applicants. Thus the obviousness double patent rejection is proper rendering the instant claims obvious.

Applicant argues that application '254 does not teach how to blend the distillates as the present instant claimed invention clearly does. Applicants' attention is directed to the fact that the instant claims are not directed to a method nor a process for producing a blend, but are directed to a blended composition. The instant pending claims of record is not commensurate in scope with the rule 132 affidavit of Berlowitz, which is directed to specific relative proportion for the blend. The teachings of applicants of '254 for a blend comprising the F-T distillate and the raw virgin distillate blend rendering the instant claims obvious. Thus the obviousness double patent rejection is proper and the instant claims are rendered obvious .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-

308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. B. Medley/mn
May 21, 2003

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER